

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/753,270

Applicant: Feygenson

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TC/AU: 3629

Examiner: Casler, Traci

Docket No.: 225265

Customer No.: 23460

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. SECTION 41.41

Dear Sir:

Applicants respectfully submit this Reply Brief in response to the Examiner's Answer mailed on November 5, 2007. Appellants hereby respectfully request allowance of the pending claims for the reasons set forth in Appellants' Brief filed on July 27, 2007, and for the further reasons stated herein.

I. Status of Claims

Claims 16-19 and 21-32 are pending. Original claims 1-15 and 20 have been withdrawn. Claims 16-19 and 21-32 stand finally rejected, and these rejections are presently being appealed.

A complete listing of these claims appears in the Claims Appendix.

II. Grounds of Rejection to be reviewed on Appeal

The grounds of rejection to be reviewed on appeal are the grounds stated in the Final Office Action mailed on April 17, 2006. In particular, Appellants appeal:

1. The rejection of claims 21-32 under 35 U.S.C. 112, as failing to comply with the written description requirement.
2. The rejection of claims 16-18 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,567,784, filed on June 3, 1999 (“Bukow”).
3. The rejection of claims 19 and 21-32 under 35 U.S.C. 103(a) as being obvious over Bukow in view of www.medquist.com, purportedly retrieved from the “Wayback Machine” on June 8, 2003 (“Medquist”).

III. Argument in Reply to the Answer

Appellants have carefully reviewed the Examiner's Answer. The Grounds of Rejection Section (9) of the Answer, beginning at page 3 and ending at page 6, restates the grounds recited in the Final Office Action from which the present appeal was taken. Appellants have previously addressed the grounds for rejection in their Appeal Brief, and Appellants will not repeat these arguments. However, the discussion below addresses the points raised in the Answer's Response to Argument Section (10).

Reply to the Answer's Argument Regarding
Rejection of Claims 21-32 under 35 U.S.C. § 112

The Examiner's Answer contends that "claim limitations" may not be "narrower than that of the specification." (*Answer* at 3-4, 6-7.) This rejection cannot be sustained.

It is axiomatic that an inventor may claim an invention that is "narrower" than the embodiments described in the specification. *See Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1378, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000) ("[i]t is a familiar principle of patent law that a claim need not be limited to a preferred embodiment.") Indeed, dependent claims by their very nature are "narrower" than the claims from which they depend, which in turn must be supported by the specification. Likewise, an inventor who describes a genus and a species in the patent specification may present claims to the broader "genus" and to the "narrower" species.

The specific rejection at issue is that "Applicant fails to disclose a contractor as a candidate therefore leaving the claim limitations narrower than that of the specification." (*Answer* at 3.) Applicants, however, identified by page and paragraph the specification's support for how participants in the Employee Work Program ("EWP") choose their own hours, locations, types of work and even employers. (*Appeal Br.* at 5.) By definition, such participants would indeed be considered independent contractors. (*Id.*) What is more, the specification describes a new employment system and method to address the problem of unemployed and underemployed workers. The participants in the program are not conventional employees.

Importantly, the Examiner concedes that the term “independent contractor” has a known meaning. (*Answer* at 6.) It also appears to concede that the specification describes EWP participants as meeting the requirements for appropriate characterization as “independent contractors.” (*Id.* at 7.) These concessions should establish beyond dispute that the specification adequately describes a method involving independent contractors.

The Examiner’s Answer avoids this issue by misstating the law regarding the written description requirement. In particular, the Answer erroneously contends “*The applicant has the burden of showing that a person of skill in the art would have understood, at the time the application was filed that the description requires the limitation.*” (*Answer* at 7 (emphasis added).) Nothing in the case cited by the Examiner, *Hyatt v. Boone*, 146 F.3d 1348, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998), establishes such a requirement. Indeed, the law is to the contrary.

The Federal Circuit actually places the burden *on the examiner* to establish the lack of written description. *In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578, 1583-4 (Fed. Cir. 1996). Where, as here, “the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.* In the present case, the Examiner has not offered any evidence or reasons to meet her burden.

Moreover, the test is not whether “the description requires the limitation” as argued in the Examiner’s brief. Instead, the Federal Circuit has instructed that an applicant must only convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in “possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q. 2d 1111, 1117 (Fed. Cir. 1991). The Court further has cautioned that “[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The appropriate test, therefore, is whether the Applicants’ specification demonstrated possession of the invention as involving independent contractors as participants. To answer this question, Applicant’s Appeal Brief pointed to the support in the specification for this exact claimed feature. The fact that *broader* subject

matter is also described does not mean that the Applicants must expand their claims to cover all such embodiments. The specification describes methods and systems in which participants in an EWP are independent individual contractors, and Applicants have the right to claim such embodiments.

Under the correct legal analysis, the rejection of claims 21-32 for lack of written description under 35 U.S.C. § 112 should be reversed.

Reply to the Answer's Argument Regarding
Rejection of Claims 16-18 under 35 U.S.C. § 102(e)

The Examiner's Answer again argues that rejected claims 16-18 are anticipated by Bukow. Bukow, however, manifestly does not describe the step of "determining several types of atomic units of work needed to perform a task."

The Examiner's Answer does not fairly meet Applicant's argument. In response to Applicants' arguments, the Examiner offers the possibility that Bukow's website artwork may be an atomic unit of work that is part of a larger task. Even if this argument is credited, Bukow does not describe the step of determining *several* types of atomic units. The hypothesized website may or may not include work in addition to "artwork" that a business would subdivide. Bukow is simply silent on the point. Bukow further fails to describe at all the concept of "several types" of atomic units of work needed to perform a task. As noted in Applicants' Appeal Brief, even if the "artwork" could be considered an atomic unit of work, Bukow does not describe the step of determining different "types" of atomic units of work needed to perform a task.

The Examiner attempts to sidestep this problem by arguing that "the proceeding steps simply require 'at least one' type of atomic unit to be performed." (*Examiner's Answer* at 8.) Although this is correct, claim 16 nevertheless still requires the step of *determining several* types of atomic works. Because Bukow does not describe this step, expressly or inherently, it cannot possibly anticipate claim 16.

The Examiner's answer also avoids joining issue on claim 18. This claim requires "an indirect message delivery process," which is an announcement made only to selected qualified prospective participants, who may accept the opportunity and/or pass the

opportunity to other prospective candidates. (*See* Specification, pp. 13-14, ¶ 51.) The “indirect” message delivery process is differentiated from a “direct” message process. In the indirect process, which is claimed, only a select group of previously qualified participants receive notice. (*Id.*) In the direct process, all previously qualified participants receive notice. (*Id.*) Bukow arguably discloses a “direct” message process, which the Examiner notes at page 9 of the Answer, but it does not disclose the “indirect” process.

For the foregoing reasons, Bukow does not describe the subject matter of claims 16-18. The Office Action’s rejection of these claims as being anticipated by Bukow should be reversed.

Reply to the Answer’s Argument Regarding
Rejection of Claims 19 and 21-32 under 35 U.S.C. § 103(a)

Applicants again respectfully request reversal of the rejection of claims 19 and 21-32 as being obvious. Applicants incorporate by reference, but do not repeat here, their arguments regarding the lack of any teaching, suggestion or motivation to combine the Bukow reference with the Medquist reference.

Applicants further stand by their prior arguments that Bukow does not describe actual claim limitations. This reference does not disclose the steps of “separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers” and then “determining the type of atomic units of work needed to perform the subparts” (Claim 19) and “offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work” (Claim 21). Even if the Examiner’s argument (at page 10) regarding Bukow’s description of website artwork is credited, Bukow manifestly does not describe the step of determining *several* types of atomic units.

In addition, neither Bukow nor Medquist describe the step in claim 21 of “receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet.” The Examiner’s Answer (at p. 5) concedes that Bukow does not describe this limitation, but it then cites to a section of Medquist (p. 18, ¶ B) that describes a *client’s* use of the Internet. This portion of Medquist does not describe in any way the activities of the person who actually performed the work. As such, the Examiner has

failed to establish a prima facie case of obviousness even assuming that the hypothetical combination of Bukow/Medquist is proper.

In addition, the hypothetical combination of Bukow/Medquist simply do not teach the steps set forth in claims 22-32. Among other things, Medquist describes a medical coding operation; it does not describe a work process for reviewing a document for typographical errors (claim 22) or transcription (claim 23) for a certain duration (claim 24). It also does not describe a work process for insurance claims (claims 25, 26) or processing accounts payable (claim 27). Likewise, neither Bukow nor Medquist address the qualifications of participants as measured by English language skills (claim 28), a high school diploma (claim 29), or completion of a specialized training program tailored to the specific atomic unit of work (claim 30). Finally, there is nothing in either reference that screens candidates based on prior experience in conducting the particular type of atomic units of work (claims 31, 32). The rejections involving these claims should be rejected due to the absence of a prima facie case of obviousness.

Conclusion

In summary, the invention, as set forth in the rejected claims, has adequate written description support in the specification and, further, is not anticipated or rendered obvious from the combined teachings of Bukow or Medquist. For these reasons, as well as others stated herein above, the presently pending claims are patentable over the prior art presently known to Appellants.

Appellants therefore request reversal of the presently pending rejection of claims 16-19 and 21-32.

Respectfully submitted,



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IV. Claims Appendix

Claims 1-15 are withdrawn.

16. A method for efficiently accessing, engaging and managing human resources to perform a task, the method comprising the steps of:

determining several types of atomic units of work needed to perform a task;

announcing to a pool of potential applicants a need to have at least one type of atomic unit of work performed, wherein the work is capable of being transmitted electronically over the Internet and wherein the pool includes at least one applicant who is qualified to perform the at least one type of atomic unit of work;

selecting at least one candidate from within the pool to perform the at least one type of atomic unit of work;

negotiating a payment for each atomic unit of work with the at least one selected candidate;

paying each selected candidate the negotiated payment for each atomic unit of work performed.

17. The method of claim 16, wherein the pool of applicants is limited to those having certain predetermined credentials.

18. The method of claim 16 further comprising the step of determining the pool of potential candidates via an indirect message delivery process.

19. A method for efficiently performing a task, the method comprising the steps of:
separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers;

determining the type of atomic units of work needed to perform the subparts of the task that may be performed on an atomic unit basis;

selecting at least one candidate to perform each type of atomic unit of work;

receiving the work product for each performed atomic unit of work over the Internet;

paying each selected candidate for each received atomic unit of work on a predetermined basis.

21. A method for efficiently utilizing the skills of individual independent contractors, whose individual skills have been input as searchable data in an electronic database, the method comprising the steps of:

searching the database to identify a group of individual independent contractors whose skills, as indicated by the data in the database, match the criteria necessary to complete a type of atomic unit of work;

offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work;

selecting at least one individual independent contractor from the group to perform the type of atomic units of work;

providing the selected individual independent contractor with uncompleted atomic units of work;

receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet;

paying the selected individual independent contractor for each completed atomic unit of work.

22. The method of claim 21, wherein a type of atomic unit of work is reviewing a document of predetermined length for typographical errors.

23. The method of claim 21, wherein a type of atomic unit of work is transcribing dictation of a predetermined duration.

24. The method of claim 23, wherein the predetermined duration is ten minutes.

25. The method of claim 21, wherein a type of atomic unit of work is verifying data relating to an insurance claim.

26. The method of claim 25, wherein data relating to an insurance claim includes a description of the events leading to the claim.

27. The method of claim 21, wherein an atomic unit of work is processing an invoice in an accounts payable file.

28. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes the ability to read the English language.

29. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a high school diploma.

30. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a certification of completion of specialized training pertaining to the type of atomic unit of work.

31. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a predetermined level of prior experience in conducting the type of atomic unit of work.

32. The method of claim 31, wherein the predetermined level of prior experience is the prior completion of 100 atomic units of work of the type of atomic unit of work.

V. Evidence Appendix

Not Applicable

VI. Related Proceedings Appendix

Not Applicable